

PATENT
App. Ser. No.: 09/648,572
Atty. Dkt. No. ROC920010079US1
PS Ref. No.: IBMK10079

REMARKS

This is intended as a full and complete response to the Office Action dated November 16, 2005, having a shortened statutory period for response set to expire on February 16, 2006. Applicants submit this response to place the application in condition for allowance. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-8, 10, 12-16, 20-21, 25-29, and 42-46 are pending in the application. Claims 1-8, 10, 12-16, 20-21, 25-29, and 42-46 remain pending following entry of this response.

Claim Rejections - 35 U.S.C. §103

Claims 1-8, 10, 12-16, 20-21, 25-29, and 42-46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Tedesco et al.* (US 6,085,888, hereinafter *Tedesco*) in view of *Kim et al* (US 6,330,490, hereinafter *Kim*). Applicants respectfully traverse this rejection.

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2142. To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP § 2143. The present rejection fails to establish at least the first and third criteria.

All Claim Limitations Not Taught

Claimed embodiments are directed to operating a reservation control system wherein the system, upon receiving a request from a computer, determines if the requested item is available at a vending machine, and if so, reserves the item at that vending machine.

PATENT
App. Ser. No.: 09/648,572
Atty. Dkt. No. ROC920010079US1
PS Ref. No.: IBMK10079

The Examiner argues that *Tedesco* discloses the steps "of operating a reservation control system for reserving items dispensed by a vending machine networked to a reservation control system comprising the steps of: receiving a reservation request from a vending machine computer for an item (see col. 7, lines 1-13, fig. 2); determining whether the item is available at a vending machine (see col. 6, lines 6- 26); and reserving the item by placing a hold on it (see col. 8, lines 3-17 and col. 9, lines 34-50)."

For brevity, Applicants have restricted the scope of their arguments. However, the arguments made in the Applicants' previous response in regards to *Tedesco* (mailed on September 1, 2005) are still applicable in view of the current rejections and, accordingly, the previous response is hereby incorporated by reference. In particular, Applicants' reassert that *Tedesco* does not disclose "reserving the item by placing a hold on it", as suggested by the Examiner.

The Examiner concedes that *Tedesco* does not "disclose the step of reserving the item to ensure availability of the item in satisfaction of the reservation request and the step of calculating a service charge." However, the Examiner argues that *Kim* discloses "calculating a service charge for the item according to a length of time for which the item was reserved."

Kim is directed to providing a data vending machine that minimizes the time required for buying a data file such as a music file. See Col. 2, Lines 52-55. *Kim* also provides a system and method for storing data on a remote data vending machine, and a system and method for recording the data file onto a recording medium. See Col. 2, Lines 56-65.

The Examiner argues that *Kim* teaches "calculating a service charge for the item according to a length of time for which the item was reserved." Specifically, the Examiner argues that *Kim* discloses a service charge in the following text:

To achieve the above objects, there is provided a data vending method which includes a first step for selecting a list of data files among the lists of a plurality of data files stored in the host computer and reserving the selected data

PATENT
App. Ser. No.: 09/848,572
Atty. Dkt. No. ROC920010079US1
PS Ref. No.: IBMK10079

files, a second step for receiving the data files which are not stored in the data vending machine among the reserved data files from the host computer and updating a database of the data vending machine using the received data files, a third step for checking whether a reservation is made when a procurement is requested by a customer, a fourth step for displaying the data files included in a reservation information having a reservation number identical to the stored reservation information on a screen and checking whether a charge payment is made when a reservation is made, a fifth step for instructing the reserved data files to be recorded onto a recording medium when the charge payment is made and storing a sold information of the data files which will be recorded, a sixth... (*Kim* Col. 4, Lines 5-21).

Respectfully, Applicants submit that the Examiner errs in this conclusion for the reasons that follow. Nowhere in the text cited by the Examiner, nor anywhere else in *Kim*, is functionality relating to "calculating a service charge for the item according to a length of time for which the item was reserved" disclosed. Although *Kim* does disclose a "charge payment" for a reserved item, *Kim* does not disclose a relationship between calculating a service charge according to a length of time that the item was reserved.

In addition, *Kim* teaches reserving "in order to rapidly record a music file request by a customer onto a recording medium". See Col. 10, Lines 24-27. In *Kim* a customer "reserves" an item in the sense that the customer selects multiple files for a recording and returns later to retrieve his or her CD. See Col. 12, Lines 29-42. The files are either present in a local database on the remote vending machine, or if not present in the local database, they are downloaded from a central host computer. See Col. 11, Lines 25-35. When a customer returns to the *Kim* vending machine the files are recorded onto a recording medium, e.g. a CD, for the customer. See Col. 12, Lines 29-42.

Thus, *Kim* does not teach reserving an item "to ensure availability of the item at the vending machine in satisfaction of the reservation request", rather *Kim* reserves "in order to rapidly record a music file request by a customer onto a recording medium."

It follows that since *Kim* does not disclose reserving an item "to ensure availability of the item at the vending machine in satisfaction of the reservation request" it also does not disclose "calculating a service charge for the item according to a length

PATENT
App. Ser. No.: 09/848,572
Atty. Dkt. No. ROC920010079US1
PS Ref. No.: IBMK10079

of time for which the item was reserved", since the latter limitation is premised on the former. Therefore, the rejection is believed to be improper and Applicants respectfully request that the rejection be withdrawn and the claims be allowed.

No motivation to combine: The Examiner's proposed modification renders the prior art unsatisfactory for its intended purpose

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2142. To establish a *prima facie* case of obviousness there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one ordinary skill in the art, to modify the reference or to combine the reference teachings. *Id.* "If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." (MPEP § 2143.01 citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

Respectfully, Applicants submit that the Examiner's proposed modification would render the prior art, *Kim*, unsatisfactory for its intended purpose. *Kim* proposes a plurality of data vending machines connected to a host computer. See Col. 3, Lines 44-47. The purpose of the *Kim* patent is to reduce the amount of time it takes to record a data file, for example a music file, onto a recording medium, e.g. a CD. See Col. 2, Lines 51-65. *Kim* contemplates that some songs will need to be downloaded from a central computer if they are not available on the remote vending machine. See Col. 4, Lines 6-12. *Kim* also contemplates that some songs will be more popular than others, and thus a remote vending machine will have a local database for storing more popular songs so that the more popular songs will not need to be downloaded every time a customer desires to purchase the song from the vending machine. See Col. 11, Lines 26-35; Col. 11, Lines 57-60.

If *Kim* is characterized as disclosing "reserving the item comprises placing a hold on the item at the vending machine to prevent the item from being purchased by any person other than a person for whom the reservation request is made" as argued by the

PATENT
App. Ser. No.: 09/848,572
Atty. Dkt. No. ROC920010079US1
PS Ref. No.: IBMK10079

Examiner, it would render *Kim* unsatisfactory for its intended purpose. *Kim's* purpose is to allow people at remote vending machines to rapidly create CDs. See Col. 2, Lines 51-65. If one person at one vending machine were allowed to "place a hold" on a popular song so that others were prevented from purchasing that popular song, no one would use the *Kim* vending machine. No one would use the *Kim* vending machine because only one individual on the entire *Kim* network of vending machines would be able to purchase a song or songs which are at the time very popular. It would be nonsensical to restrict your market to only one person at a time being able to create a CD with popular songs.

Therefore, the claims are believed to be allowable, and allowance of the claims is respectfully requested.

Conclusion

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



Gero G. McClellan
Registration No. 44,227
PATTERSON & SHERIDAN, L.L.P.
3040 Post Oak Blvd. Suite 1500
Houston, TX 77056
Telephone: (713) 623-4844
Facsimile: (713) 623-4846
Attorney for Applicant(s)